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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,222	11/05/2003	Kate O'Hara	100041-41188	7987

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EXAMINER

HENDERSON, MARK T

ART UNIT PAPER NUMBER

3722

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/702,222	<b>Applicant(s)</b> KATE O'HARA	
	<b>Examiner</b> Mark T Henderson	<b>Art Unit</b> 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                              |                                                                                         |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/17/04</u> . | 6) <input type="checkbox"/> Other: ____.                                                |

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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1. Claims 1-12, 16-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris (2,486,840) in view of Bostroem (Des 482,162).

Harris discloses in Fig. 1, 5 and 7, a notebook comprising: a plurality of paper (24 in Fig. 5) bound together having an elongate opening (26), wherein each opening is aligned with an opening of any adjacent sheets and sized to receive a writing instrument (27); a cover (23) coupled to the sheets (24), wherein the cover lacks any opening; wherein the sheets and cover are aligned; wherein the sheets include a plurality of printed lines (see Fig. 1); a spiral binding mechanism (25); wherein the cover is pivotally bound to the sheets of paper; wherein the cover and sheets include binding holes (see Fig. 5) located adjacent inner edge (22); a supplemental cover (21); a tear guide line (12, in Fig. 1); wherein the cover covers about 50% of the openings and configured to retain the writing instrument.

However, Harris does not disclose a notebook comprising a retaining means to secure cover in a closed position; wherein the elongate opening is located adjacent to binding mechanism; wherein each opening is at least 6 inches in length with a length-to-width ration of 6:1; wherein the opening is sized to receive a writing instrument of a length of 4 inches to 7 inches and a width of 1/8 - 1 inch.

Bostroem discloses in Fig. 7 and 8, a notebook comprising a retaining mechanism (A) having a snap portion, wherein the mechanism is attached to a cover and can be coupled to a supplemental cover.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Harris' notebook with a retaining mechanism as taught by Bostroem to keep the covers secured in a closed position.

In regards to **Claim 7**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the elongate openings at any location, since it has been held that rearranging parts of an invention involves only routine skill in the art. Therefore, it would have been obvious to place the openings at any location, since applicant has not disclosed the criticality of having the openings at a particular position, and invention would function equally as well in any location.

In regards to **Claims 16, 17 and 23**, it would have been an obvious matter of design choice to construct the openings and writing instrument at any desired size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. Therefore, it would have been obvious to construct the openings and writing instrument at any size, since applicant has not disclosed the criticality of having a particular opening and writing instrument size, and invention would function equally as well if constructed in any size.

2. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris in view of Bostroem, and further in view of Vernon (672,723).

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Harris as modified by Bostroem discloses a notebook comprising all the elements as claimed in Claim 1, and as set forth above. However, Harris does not disclose wherein the opening includes an enlarged portion centrally located along a length of the opening, wherein the enlarged portion extends in a direction perpendicular to the length of the opening.

Vernon discloses in Fig. 2, a notebook comprising an enlarged portion centrally located along a length of the opening, wherein the enlarged portion extends in a direction perpendicular to the length of the opening.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Harris' and Bostroem's notebook with an opening having an enlarged portion as taught by Vernon so that the end user may remove the writing instrument from the opening.


#### ***Prior Art References***

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. German Patent (DE-319330), Strayer, Paine, Evert, O'Boyle, Schieppati et al, Soussan, and Lake disclose similar notebooks.

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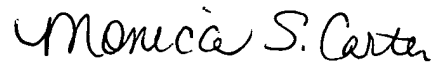
**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571)272-4477. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, Derris Banks, can be reached on (571) 272-4419. The fax number for TC 3700 is (703)-872-9306.



MTH

March 20, 2005



**MONICA S. CARTER  
PRIMARY EXAMINER**